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REMARKS**I. Introduction**

First, once again, Applicants and Applicants' attorney wish to thank Examiner Ometz for his effort and assistance in expediting the prosecution of the above-identified reissue application.

In the above-identified Office Action, claims 6-10 and 12-16 were rejected under 35 U.S.C. § 251 for violation of the recapture doctrine. For the reasons set forth below, it is respectfully submitted that application of the test promulgated by the Federal Circuit concerning recapture makes it clear that the pending claims do not violate the recapture doctrine. Accordingly, Applicants respectfully submit that the pending rejection must be withdrawn.

II. Claims 6-10 And 12-16 Do Not Violate The Recapture Doctrine

Claims 6-10 and 12-16 were rejected under 35 U.S.C. § 251 as being improper recapture of broadened claimed subject matter surrendered in the parent application. Applicants respectfully submit that applying the relevant test set forth by the Federal Circuit makes it clear that the rejected claims do not violate the recapture doctrine.

In formulating the pending rejection, three Federal Circuit cases are cited in support of the rejection, *Hester Industries v. Stein, Inc.*, 142 F.3d 1472 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d (Fed. Cir. 1984). However, upon review of each of these cases, it is clear that application of the test for determining if reissue claims are attempting recapture subject

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matter surrendered to obtain the original patent leads to the conclusion that the rejected claims are not attempting to recapture surrendered subject matter.

As stated by the Federal Circuit, the test for determining whether the recapture has been violated is essentially a two step test. As stated by the Court in *In re Clement*, the first step is to determine whether and in what aspect the reissue claims are broader than the original patent claims (i.e., the claims that issued in the patent on which the reissue application is based). *In re Clement*, 131 F.3d at 1468. The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. This is done by analyzing the prosecution history and previous amendments to determine what subject matter was surrendered. In other words, the second step entails determining whether the surrendered subject matter has crept into the reissue claim. *In re Clement*, 131 F.3d 1469.

With regard to the second step, as stated by the Federal Circuit in *In re Clement*, this is accomplished by "*comparing the reissue claim with the cancelled claim*". *Id.* at 1469. The Court further stated that if the scope of the reissue claim is the same or broader than the cancelled claim, the patentee is attempting to recapture surrendered subject matter and the reissue claims cannot be allowed. However, ***if the reissue claim is narrower in scope than the cancelled claim, the recapture rule is not applicable.*** *Id.* at 1469. (See also, *Ball Corp.*, 729 F.2d at 1436, "[T]he patentee is free to acquire, through reissue, claims that are narrower in scope than the cancelled claims".)

Turning to the currently rejected reissue claims, as will be explained in more detail below, the pending reissue claims are unquestionably narrower than the

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cancelled claims, and therefore, the recapture rule is not applicable to the reissue claims. It would seem that in applying the foregoing recapture test, the Special Programs Examiner, mistakenly compared the reissue claims to the original issued patent claims, and not the cancelled claims. This led to the erroneous conclusion that the reissue claims were broader, and therefore the recapture doctrine was applicable. However, while the reissue claims are broader than the originally issued claims, they are unquestionable narrower than the claims surrendered during prosecution, and therefore the recapture doctrine is not applicable.

Applying the foregoing test to reissue claim 6, which corresponds to claim 1 of the '622 patent, it is clear that reissue claim 6 is broader than originally issued claim 1. Thus, the next step of the test is to determine if the reissue claim is broader or narrower than the cancelled claim.

Prior to the amendment filed on July 25, 1997, pending claim 1 of the application read as follows:

Claim A: A cartridge for housing a recording medium therein, comprising:
a cartridge body configured such that a signal recording apparatus can record a signal onto said recording medium when said cartridge is loaded in said signal recording apparatus;
an opening in said cartridge body for removing said recording medium from said cartridge body; and
an indicator for indicating whether said cover has ever been opened or removed from said cartridge body.

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The amendment filed on July 25, 1997, which substantially revised claim 1, essentially placed the claim in condition for allowance. Accordingly, Claim A represents the "surrendered" subject matter of the parent application as concerns claim 1. Claim B set forth below is reissue claim 6, which also corresponds to claim 1.

Claim B: 6. A cartridge for housing a recording medium therein, comprising:
a cartridge body configured such that a signal recording apparatus can record a signal onto [said] a removable recording medium housed within said cartridge body when said cartridge body is loaded in said signal recording apparatus;
an opening in said cartridge body for removing said recording medium from said cartridge body; and
an indicator for indicating whether [said] a cover over said opening has ever been opened or removed from said cartridge body and for providing such an indication to an electrical detecting device,
wherein said indicator comprises a detachable claw mounted to said cartridge such that detaching said claw from said cartridge enables a user to unlatch a latch of said cover and thereby open or remove said cover from said cartridge body.

Thus, comparing Claim B to Claim A, it is clear that Claim B is narrower than Claim A in all respects. As such, in accordance with the test set forth by the Federal Circuit, the recapture rule is not applicable to Claim B. Indeed, application of the test is clear, and no other conclusion can be reached.

Furthermore, it is respectfully submitted that the remaining reissue claims are all narrower than the subject matter surrendered during the prosecution of the '622 patent. If required, Applicants will provide a comparison similar to that set forth above for the

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remaining claims. However, Applicants believe that it is clear that all of the reissue claims are unquestionable more narrow than the subject matter surrendered during prosecution of the '622 patent.

Turning now to the comments set forth in the Office Action, with regard to claims 6-10, much of the focus is directed to the fact that the Examiner included the phrase "detaching the claw from the cartridge body (emphasis added)" in the reasons of allowance. Indeed, elimination of the word "body" from this phrase is the basis for the recapture rejection.

However, as is clear from the foregoing, reissue claim 6 is clearly narrower than the subject matter surrendered via claim amendments. Thus, if the assertion of the pending rejection is true, the only remaining possibility is that this subject matter was surrendered via argument. As set forth by the Federal Circuit in *Hester*, in order for subject matter to be surrendered via argument, there must be "deliberate assertions made in order to obtain allowance of the original patent claims". *Hester*, 142 F.3d at 1481 (emphasis added). Clearly, that is not the case here. It is further noted that it is arguable if analysis of statements made by the Applicants should be considered when the claims have been amended (i.e., the claim amendments define the surrendered subject matter). However, in an effort to address all possible issues, Applicants also explain why the statements relied upon in the pending rejection do not constitute surrender of subject matter.

First, when arguing the distinctions of claim 1 over the prior art, Applicants made no assertions regarding "cartridge body" that could be deemed to be a surrender of subject matter. Indeed, just the opposite occurred. As set forth on page 8 of the

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amendment filed on July 25, 1997, when referring to the detachable claw, the

Applicants stated that:

The indicator comprises a detachable claw mounted to the cartridge such that detaching the claw from the cartridge enables a user to open or remove the cover from the cartridge.

As is clear, Applicants made no reference to the cartridge body, Applicants simply referred to the cartridge. Indeed, throughout the amendment, the Applicants made no distinction between the cartridge and the cartridge body. As such, it cannot be properly concluded that the Applicants have surrendered such subject matter.

Moreover, with regard to the Examiner's statement set forth in the reasons of allowance, as is clear, the Examiner was simply paraphrasing the claim language of the limitation the Examiner believed to distinguish the claim over the prior art. And while the claim language did include the term "cartridge body", it is clear from the prosecution history that the distinction the Examiner was focussing on was the recitation of the "detachable claw" limitation, which was added in the amendment dated July 25, 1997. Nowhere is there any suggestion that reliance was made on the term "cartridge body" as a means of distinguishing over the cited prior. Accordingly, there has been no surrendered of the subject matter set forth in claim 6-10 of the pending reissue application.

Turning to claims 12-16, as stated above, pending claims 12-16 are all clearly more narrower than the corresponding subject matter surrendered via claim amendment in the '622 patent. Thus, the only manner in which the subject matter of reissue application could have been surrendered would have been by argument.

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The pending rejection of claims 12-16 asserts that the use of the term "engaging" as opposed to "mounted to" represents recapture. Applicants submit this conclusion is in error. As set forth above, in order to surrender subject matter via argument, the Applicant must have made "deliberate assertions" that the recitation was the basis for patentability. Reviewing the amendment filed on June 25, 1997, it is clear that any deliberate assertion was made in reference to the detachable claw. Specifically, the distinction argued was the inclusion of the detachable claw in the device, not how the claw was secured to the cartridge. As such, it cannot be concluded that the Applicants surrendered subject matter regarding how the claw is secured to the cartridge. Thus, changing the term "mounted to" to "engaging" does not violate the recapture doctrine.

Accordingly, it is respectfully submitted that claim 6-10 and 12-16 are not attempting to recapture subject matter surrendered during the prosecution of the '822 patent, and therefore do not violate the recapture doctrine. As such, it is respectfully requested that the pending rejection of claims 6-10 and 12-16 be withdrawn.

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III. Conclusion

Having fully and completely responded to the Office Action, Applicants submit that all of the pending claims are in condition for allowance, an indication of which is respectfully solicited.

Respectfully submitted,

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